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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,740	05/04/2001	Paolo M.B. Tiramani	0103100027143	9980

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EXAMINER	
VANAMAN, FRANK BENNETT	
ART UNIT	**PAPER NUMBER**
3618	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/849,740	TIRAMANI ET AL.	
	Examiner	Art Unit	
	Frank Vanaman	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *34-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *34-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Status of Application

1. Applicant's amendment, filed April 28, 2005, has been entered in the application, claims 34-45 currently pending.

Claim Rejections - 35 USC 103

2. The portions of 35 USC 103 relied upon herein may be found cited in a previous office action.

3. Claims 34-45 are rejected as being unpatentable over Hancock et al. (US 5,983,614, filed 12/1997) in view of Pickard (US 5,551,715). Hancock et al. teach a caster for a frame portion including a caster frame (50) attached to the portion, a wheel (51) rotatably mounted for rotation about an axis perpendicular to a swivel axis, the wheel and caster being capable of free swiveling (figure 2) when the wheel is in contact with a ground surface, or when the wheel is not in contact with a ground surface; or being locked in a predetermined swivel orientation (figure 1), when the wheel is in contact with a ground surface, or when the wheel is not in contact with a ground surface, the wheel assembly being movable in a longitudinal direction (associated with longitudinal motion of the frame or device to which it is attached); the frame including a guiding means (20) having a v-shape, which engages with a pin (56) on a rod, the wheel turnable about the rod axis, the frame including a biasing means (70) for biasing the wheel and caster frame into the desired orientation, either when the wheel is bearing against the surface, or when it is not; the frame including a swivel (32) and the wheel mounted in a frame portion (52) which may pivot. The reference to Hancock et al. does not the caster device as being attached to an item of luggage, or a retractable portion of an item of luggage. Pickard teaches an item of luggage (2) having a plurality of caster wheels (6) mounted for pivotal motion about wheel axes (not referenced) and swivel-able about caster axes (through 14), attached to a retractable portion (4) of the luggage. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the selectively swiveling caster structure taught by Hancock et al. to a retractable portion of a caster-equipped luggage item as taught by Pickard, for the purpose of allowing the luggage to be selectively set in a non-steerable configuration. The references to Hancock et al. and Pickard fail to specifically teach the automation of

the selective swiveling, however Hancock does teach a manually initiated selective swivel mode selection. Inasmuch as the automation of a taught manual process is not deemed to be beyond the skill of the ordinary practitioner, it would have been obvious to one of ordinary skill in the art at the time of the invention to automate the selective swiveling selection so as to allow the user to easily initiate the swivel mode selection without requiring substantial mechanical effort on the part of the user.

Response to Comments

4. Applicant's comments concerning the reference to Hancock et al., previously applied against the claims singly, have been considered, and the examiner agrees that the reference to Hancock et al., by itself, fails to teach each and every limitation set forth in the claims as now recited. Note that the recitation "for luggage" constitutes only a statement of intended use and carries little patentable weight, while the recitation in the claims ("attached to said retractable portion of the luggage" in claim 34; "...rotatably attached to said luggage" in claim 40) does positively include the luggage in the claim recitation, hence the combination with the reference to Pickard, which teaches an item of luggage having a retractable portion.

In general, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

It is well held that it is not beyond the skill of the ordinary practitioner to broadly provide a mechanical or automatic means to replace manual activity which accomplishes the same result (see *In re Venner* 120 USPQ 192 (CCPA 1958) and *In re Rundell* 18 CCPA 1290, 48 F.2d 958, 9 USPQ 220).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A response to this action should be mailed to:
Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,
Or faxed to:
PTO Central Fax: 571-273-8300

F. VANAMAN
Primary Examiner
Art Unit 3618

7/4/05